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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/772,493	02/05/2004	Tina L. Bramlett	SNR.P.2220 B	4966

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JOSEPH G CURATOLO, ESQ.
CURATOLO SIDOTI CO. LPA
24500 CENTER RIDGE ROAD, SUITE 280
CLEVELAND, OH 44145

EXAMINER	
DIXON, MERRICK L	

ART UNIT	PAPER NUMBER
1774	

DATE MAILED: 05/19/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/772,493	BRAMLETT ET AL.	
	Examiner	Art Unit	
	Merrick Dixon	1774	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *Response filed 2-3-05*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-37* is/are pending in the application.

4a) Of the above claim(s) *20-37* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-19* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

MERRICK DIXON
PRIMARY EXAMINER

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *2-5-04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

1. In response to Applicants remarks filed 2-3-05, the instant office action is submitted. This office action is a non-final action on the merit. The outstanding action of 11-29-04, is hereby withdrawn and the instant action submitted therefor. Claims 1-19 are to be examined and claims 20-37, withdrawn, accordingly.

2. The abstract of the disclosure is objected to because it includes the legal word, "comprising". Correction is required. See MPEP § 608.01(b).

3. Claims 7,13,14,15,16 and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
The claims include improper Markush groups. Applicants are requested to provide related corrections.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 1-6,11, 12 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Starke et al(US 6564520 B1).

The cited reference teaches the claimed invention including an exterior finishing system comprising a substarte(10), a bond-compatible composite(12), with adhesive material(18) and fabric layer(20A). Concerning claims 2,3,4, and 6, the cited reference teaches rubberized bituminous material layer and polyester fabric layer in col 2, line 44; col 3, lines 67-col 4, line 2; col 4, lines 3-5; col 5, lines 39-45. Concerning claim 5, the reference teaches nonwoven layer in 4, lines 26-29; col 7, lines 9-14. Concerning claims 11 and 12, the reference teaches additional bonding material on the fabric layer in col 7, lines 24-27. Concerning claim 18, the reference teaches a weather barrier – col 3, lines 60-65.

6. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

7. Claims 1,12,13 and 2 rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-4 of prior U.S. Patent No. 6395401 B1. This is a double patenting rejection.

8. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

9. Claims 1-19 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1,3-13,15-21 of U.S. Patent No. 6759135 B2. Although the conflicting claims are not identical, they are not patentably distinct from each other because the recited patent merely attachs the finishing system to a frame member.

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 7-10,13-17 and 19 are rejected under 35 U.S.C. 103(a) as being unpatentable over Starke et al (US6564520 B1) in view of Ingle (US 4855349). The

primary reference was discussed above, inter alla. Although the primary reference teaches material dimensions for its layers ,in col 4, lines 45, same reference is silent to its product possessing specific tensile strength. The secondary reference , however, teaches that it is known in the art to manipulate dimensions and weight amounts of finishing system , such as those taught by the primary reference, to impart desired tensile strengths thereto - col 13, lines 55-60; col 6, lines 7-30. It would have been obvious to one of ordinary skill in the art at the time the invention is made to combine the teaching of the secondary reference with the primary reference and facilitate/manipulate the tensile strengths of the primary reference's produce in an attempt to impart desired properties to same- col 6, line 9-10. The references are combinable for they relate to exterior finishing systems.

Such manipulations, as discussed, would produce finishing system with the claimed tensile values as required by claims 13-18. Concerning claim 19, the secondary reference teaches insulation finishing system in col 15, line 5 and col 14, line 49. Concerning claims 8, the secondary reference teaches the claimed material throughout its disclosure - see reference. The secondary reference indeed teaches numerous weight percentages as discussed above . Concerning claims 9 and 10, the primary reference teaches similar dimensions as claimed and discussed above. However, it is submitted that it would have been obvious to manipulate the related dimensions as articulated by the reference to obtain the claimed values because such manipulations, i.e., change in sizes of a component, are generally recognized as being within the level of ordinary skill in the art- In re Rose, 105 USPQ 237 (CCPA 1955).

12.

Applicants who wish to send a facsimile (draft copies) for the examiner's immediate review can do so by using the Examiner's personal fax number at 571-273-1520. The faxing of all papers must conform with the notice published in the Official Gazette, 1096 O.G. 30 (November 15, 1989). **NOTE: All facsimiles sent to the examiner's personal fax number should be in draft-forms and will be treated as informal. Same facsimiles will not be entered in the related applications unless otherwise agreed and noted by the examiner.**

The fax number for all other fascimile is 703-872-9306.

Information about **the status of an application** may be obtained from the Patent Information Retrieval system (**Private PAIR**).
Status inquires for **published applications** may be retrieved from either **Private PAIR** or **Public PAIR**. Questions about the PAIR system should be directed to the Electronic Business Center at **866-217-9197.**

Any questions concerning the instant communication should be directed to Examiner Dixon, at 571-272-1520, Mondays to Thursdays, between 12 noon and 8 PM, eastern time . The examiner's supervisor, Mrs. Rena Dye, can be reached at 571-272-3186.

MERRICK DIXON
PRIMARY EXAMINER